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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,789	07/28/2003	James Jannard	NOCODE2.005C1	5220
20995	7590	01/24/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP				DANG, HUNG XUAN
2040 MAIN STREET				
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IRVINE, CA 92614				
				ART UNIT
				PAPER NUMBER
				2873

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/628,789	JANNARD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Hung X. Dang	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 14 November 2005.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-29 is/are pending in the application.  
4a) Of the above claim(s) 15-29 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-14 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date . . . .  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: . . . .

1. The amendment filed on 11/14/05 has been entered.

### **Information Disclosure Statement**

2. The Information Disclosure Statement filed on 11/14/05 has been considered.

### **Claims Rejection Under 35 USC – 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 8, and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Swab et al** (6,769,767) in view of **Weyer** (4,902,120).

**Swab et al** discloses eyewear with exchangeable temples housing a transreceiver forming AD hoc networks with other device which comprises a frame 24 for holding the lenses, a pair of temples 19, 20 extending rearward from the frame, first and second speakers 60 and 62 mounted to the first and second temples respectively, so as to be translatable in a forward to rearward direction generally parallel to the temples over a first range of motion, at least one of the size of the speakers and the first range of motion being configured to provide an effective range of coverage of about 1 1/4 inches, an audio file storage and playback device disposed within the first ear stem,

52 a power storage device disposed in the second temple at least one button 50  
disposed on the first temple.

Swab et al does not teach that the first and second mounting mechanisms are configured to allow the first and second speakers, respectively, to pivot a predetermine distance about first and second predetermined pivot axes that are parallel to the first and second linear path.

Weyer however, discloses the first and second mounting mechanisms are configured to allow the first and second speakers, respectively, to pivot a predetermine distance about first and second predetermined pivot axes that are parallel to the first and second linear path (see figures 1 and 2.)

Because Swab et al and Weyer are both from the same field of endeavor, the purpose of selecting the positions of the speakers to suit the individual needs and comfort of the wearer as disclosed by Weyer would have been recognized as an art pertinent art of Swab et al.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses device, such as the one disclosed by Swab et al, with the first and second mounting mechanisms are configured to allow the first and second speakers, respectively, to pivot a predetermine distance about first and second predetermined pivot axes that are parallel to the first and second linear path, such as disclosed by Weyer for the purpose of selecting the positions of the speakers to suit the individual needs and comfort of the wearer.

### **Claims Rejection Under 35 USC - 103**

4. Claims 5-7 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Swab et al** (6,769,767) and **Weyer** (4,902,120) as applied to claims 1-4, 8 and 11-14 above, and further in view of **Vogt et al** (5,606,743).

Swab et al and Weyer discloses the claimed invention as stated above with the exception of a volume control.

Vogt et al, however, discloses radio eyewear comprises a volume turning control are included with the receiver compartments 6 and 8 (see column 5, lines 20-22.)

Because Swab et al, Weyer and Vogt et al are all from the same field of endeavor, the purpose of controlling the volume of the speaker as disclosed by Vogt et al would have been recognized as an art pertinent art of Swab et al and Weyer.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses device, such as the one disclosed by Swab et al and Weyer, with a volume control, such as disclosed by Vogt et al for the purpose of controlling the volume of the speaker.

### **Claims Rejection Under 35 USC - 103**

5. Claims 1-4, 8, and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Swab et al** (6,769,767) in view of **McManigal** (5,327,178).

Swab et al discloses eyewear with exchangeable temples housing a transreceiver forming AD hoc networks with other device which comprises a frame 24 for holding the lenses, a pair of temples 19, 20 extending rearward from the frame, first

and second speakers 60 and 62 mounted to the first and second temples respectively, so as to be translatable in a forward to rearward direction generally parallel to the temples over a first range of motion, at least one of the size of the speakers and the first range of motion being configured to provide an effective range of coverage of about 1 1/4 inches, an audio file storage and playback device disposed within the first ear stem, 52 a power storage device disposed in the second temple at least one button 50 disposed on the first temple.

Swab et al does not teach that the first and second mounting mechanisms are configured to allow the first and second speakers, respectively, to pivot a predetermine distance about first and second predetermined pivot axes that are parallel to the first and second linear path.

McMangal however, discloses the first and second mounting mechanisms are configured to allow the first and second speakers, respectively, to pivot a predetermine distance about first and second predetermined pivot axes that are parallel to the first and second linear path (see figures 4, 5, 9, 11a and 11b.)

Because Swab et al and McMangal are both from the same field of endeavor, the purpose of selecting the positions of the speakers to suit the individual needs and comfort of the wearer as disclosed by McMangal would have been recognized as an art pertinent art of Swab et al.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses device, such as the one disclosed by Swab et al, with the first and second mounting mechanisms are configured

to allow the first and second speakers, respectively, to pivot a predetermine distance about first and second predetermined pivot axes that are parallel to the first and second linear path, such as disclosed by McMangal for the purpose of selecting the positions of the speakers to suit the individual needs and comfort of the wearer.

### **Claims Rejection Under 35 USC - 103**

6. Claims 5-7 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Swab et al** (6,769,767) and **McManigal** (5,327,178) as applied to claims 1-4, 8 and 11-14 above, and further in view of **Vogt et al** (5,606,743).

Swab et al and McManigal discloses the claimed invention as stated above with the exception of a volume control.

Vogt et al, however, discloses radio eyewear comprises a volume turning control are included with the receiver compartments 6 and 8 (see column 5, lines 20-22.)

Because Swab et al, McManigal and Vogt et al are all from the same field of endeavor, the purpose of controlling the volume of the speaker as disclosed by Vogt et al would have been recognized as an art pertinent art of Swab et al and McManigal.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses device, such as the one disclosed by Swab et al and McManigal, with a volume control, such as disclosed by Vogt et al for the purpose of controlling the volume of the speaker.

7. Applicant's arguments filed 11/14/05 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the first and second mounting mechanisms are configured to allow the first and second speakers, respectively, to pivot a predetermined distance about first and second predetermined pivot axes that are parallel to the first and second linear path for the purpose of selecting the positions of the speakers to suit the individual needs and comfort of the wearer.

Applicant argued in page 7 of the remark that "McManigal does not disclose, inter alia, pivotability a predetermined distance about a pivot axis, as claimed. Therefore, even if the Swab reference could be combined with the McManigal reference, the combination still would fail to teach all the elements of Claim 1." This argument is not persuasive because McManigal does teach that the first and second mounting mechanisms are configured to allow the first and second speakers, respectively, to pivot a predetermined distance about first and second predetermined pivot axes that are parallel to the first and second linear path (see figures 4, 5, 9, 11a and 11b.)

and column 8:

ii) and sliding the sleeve along the stem, and rotating the sleeve about the stem, to bring the loudspeaker into a position spaced from the ear opening by an amount as defined in claim 1.

The invention contemplates the further step of folding the stem toward the lens means and also rotating the sleeve about the stem and into collapsed and stored position in protected proximity to the lens means.

FIGS. 11a and 11b show variously rotated positions of sleeves on eyeglasses stems.

It will further be noted that the sleeve deforms to grip the ear stem and conforms to it. The sleeve, although deformed and conforming, is still free to be manually rotated by the user. However, the sleeve and speakers hold a position even while the unit is on the head of a Jogger, for example. One size may fit a variety of glasses. When the unit is being carried in a pocket, for example, speakers are rotated inward so the entire unit is more compact.

Therefore the claimed invention does not distinguish over the cited art.

8. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (571) 272-2326.

1/06



HUNG DANG

PRIMARY EXAMINER

TC 2800